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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,913	08/22/2001	Cary L. Bates	END920010062US1	8413

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IBM Corporation
Intellectual Property Law Dept 917 Bldg 006-1
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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/934,913	BATES ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3 IDS statements</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 3629

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-4,6,7,9-19, are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, the claims only recite an abstract idea. The recited steps of selecting a location in an arena does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The specification even discloses that the producer of the event can be the one to choose what to broadcast. The step of the location selection involves no technology and is non-statutory. For the dependent claims, the same things applies, no technology is recited in the claims so the claims are non-statutory.

Art Unit: 3629

3. Claims 46,47, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed "computer program product" or "computer program element" is reciting computer software code and nothing more. Software alone is not eligible for patent rights. See MPEP 2106.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,26, the examiner notes that the preamble of the claim recites "for inclusion in a record made of an event" which sets for the intended use of the method of selecting an arena location. In the body of the claim is recited "making a video record of said location". It is not clear if the claimed method is limited to just the selection of the location or selection of the location and a making of a video of the location. The preamble indicates the method is limited to selection of location only and the body of the claim indicates otherwise. Which is correct? If the method is to include the making of a video, the preamble should be amended to recite "A method for selecting an arena location and for making a video of said location, said method comprising:" to clarify what the claimed method actually is.

For claims 11,36, is the recited chance a second chance in addition to the one recited in claim 1? The specification seems to only disclose one chance being sold so it

Art Unit: 3629

is not clear if the recitation of "a chance" is a 2nd chance or should be "said chance".

Which is correct?

For claims 14,39, this claim is considered indefinite. How can the step of randomly selecting a location be done by assigning a probability as a function of the value of a chance? This makes no sense. Does the chance even have a value? Has this been claimed previously? The step of assigning a probability does not even result in a location being selected. Also, if the chances are assigned probability values, how can it be claimed as random? That does not seem to be random to the examiner. It is not clear what the scope of this claim is.

For claims 15-17,40-42, in part because of claim 14, these claims are considered indefinite. How can one wishing to avoid infringement know what this claim means? If the probability value is 1.0, what does this really mean to a potential infringer? Because the claims do not recite what these values mean or represent, one wishing to avoid infringement will not know what it means to have a value of 1.0 versus 1.1. The same holds for values less than 1.0.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 3629

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1,3,4,6-12,18, are rejected under 35 U.S.C. 102(b) as being anticipated by a live broadcast of a football game such as the Super Bowl.

For claims 1,4,11, it is notoriously old and very well known that the Super Bowl is broadcast on television. It is also notoriously old and well known that advertisers pay to sponsor a halftime show at the Super Bowl. The claimed selling a chance with respect to a location is satisfied by a sponsor of the halftime show paying to be identified as the sponsor and having the halftime show be shown on TV. The football field is where the halftime show is to occur, so the claimed selecting an arena location is satisfied by this fact. The making a video of the location is the TV broadcast and ultimate recording of the halftime show.

For claim 3, the customer (the advertiser) is a prospective viewer as claimed. The CEO of a major company sponsoring the halftime show is considered to be a prospective viewer as claimed.

For claim 6, the sending of the video record is satisfied by the fact that the Super Bowl is broadcast on a major television network that broadcasts by cable, satellite, and over the airwaves. All of these manner is transmission result in the video being broadcast to the customers address, as well as millions of other addresses around the world.

For claim 7, the halftime show of the Super Bowl is shown during a break in the action (i.e. halftime).

For claim 8, the claimed screen the video is displayed on can be the showing of the halftime show on a huge screen at the stadium (i.e. Jumbotron) or can be the showing of the show on televisions located at the concessions stands. Sports teams have televisions located around the arena so that if a person is buying a drink or food they will not have to worry about missing any of the game, they can see it on TV. This is the same for the halftime show.

For claims 9,10, a location is a location and the term "seat location" is not considered to be any different from the location being the field of play for the halftime show. The playing field can be used to sit on, and in this sense is a "seat location".

For claims 12,18, the storing of the chance in a chance table is considered to be the accounting records that the broadcast entity must keep for accounting purposes. The accounting records would store the fact that company A paid to sponsor the halftime show at the Super Bowl.

8. Claims 1-4,6-13,18,20, are rejected under 35 U.S.C. 102(b) as being anticipated by a baseball fan purchasing a ticket to a baseball game.

For claims 1,2,4,9,10,11, the selling a chance to a customer is the customer buying a ticket to a baseball game. A fan can purchase a ticket for a seat either behind home plate (you will be on TV), or can purchase a ticket behind the dugout of the home or visiting team (you will be on TV). Baseball games are known to be broadcast on TV (i.e. World Series). During the game when the pitcher is throwing to the catcher the televised broadcast shows a view (looking from center field) of home plate, the hitter,

Art Unit: 3629

the catcher, and the umpire. Also shown are the fans in the seats immediately behind home plate. Those fans will be on TV each and every time the pitcher is shown throwing to home plate.

For claim 3, the fan is also a prospective viewer of the game because they can view it later.

For claim 6, the sending of the video record is satisfied by the fact that the baseball games are broadcast on major television networks that broadcasts by cable, satellite, and over the airwaves. All of these manner is transmission result in the video being broadcast to the customers address, as well as millions of other addresses around the world.

For claim 7, between batters (a break in the action) the game is still being broadcast live.

For claim 8, the claimed showing of the video on a screen is satisfied by the showing of the game on televisions located at the concessions stands. Sports teams like the Baltimore Orioles have long had televisions located around the arena so that if a person is buying a drink or food at a concession stand they will not have to worry about missing any of the game, they can see it on TV. This satisfies what is claimed.

For claims 12,18, the storing of the chance is considered to be the recording of the fact that a given seat is sold at the event. A complete list of tickets sold and available are maintained so that the stadium owner can keep track of seat inventory to a given event. Each ticket identifies a seat location and service level (luxury suites with waitress service as opposed to nosebleed seats with no waitress service).

Art Unit: 3629

For claim 13, the random selection of a location to show (from the record which is the entire stadium) is satisfied by the TV broadcast following the baseball during play. When the ball goes near or into the stands, the TV also shows this fact. This is in affect a random selection of location to display, being random based on where the ball goes.

For claim 20, the claimed set top box is considered to be a cable box that a customer that subscribes to cable TV would obtain. A customer of the cable company can then watch the baseball game on their home TV (video display screen).

DR
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9. Claims 1-13, 15, 18-20, 26-37, 40, 43-47, are rejected under 35 U.S.C. 102(e) as being anticipated by Novais et al. (2003/0023452). ³⁸

For claims 1-4, 7-9, 11, 13, 15, 26-29, 32-36, 38, 40, 46, 47, Novais discloses the selling of a chance to a customer which is the selling of photo services at the game/event. The customer can pay to have photos taken of themselves in their seat at the event. See paragraph 16 as well as the entire publication. The selection of an arena location is disclosed in paragraphs 20 and 31. A video record is made (photos).

For claims 5, 6, 30, 31, see paragraph 17, last 4 lines, where the claimed limitation is shown.

For claims 10, 35, a family will occupy more than one seat (i.e. a section of seats).

For claims 12, 18, 19, 37, 43, 44, the storing of the chance is the storing of the fact that a customer has paid for and requested photo services. This information is clearly saved by the system of Novais.

Art Unit: 3629

For claims 20,45, the claimed set top box is considered to be the sending of the photo to a person's email address. The customer can then display the photos on the monitor of their home computer.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novais et al. (2003/0023452). Applicant should take notice that in article claims if data is recited that is not functionally related to the article itself, it is considered to be non-functional descriptive material that will receive no patentable weight (i.e. what the chance is for, the data being saved). The intended use is also not given much patentable weight other than the prior art system is capable of being used as claimed.

For claims 21-25, Novais discloses a system as claimed. Novais discloses a vend station 17 that sells chances, stores information about those chances (a chance table), and sells packages of different options for the chances. The camera is 10 and the camera processor is 15. The processor operates exactly as claimed. Novais does not disclose a response processor (a 2nd processor) as claimed.

The use of a 2nd processor is taken to be a duplication of parts by the examiner. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Novais with a 2nd processor. Having a 2nd processor would allow the entire system to work faster.

The examiner also notes that having more than one processor does not appear to solve any particular problem or product any unexpected result, so the examiner concludes the use of a 2nd processor is a choice is computer network design.

The system of Novais does all that is claimed and the difference of having the 2nd processor is insufficient to distinguish over Novais.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Torrens-Burton (20030086123), Hardacker (20020115454), Inselberg (6434398), Coyle (20020174036), Miller et al. (20020082879), and Jain et al. (6144375) disclose systems/methods relevant to the instant disclosure and claims.

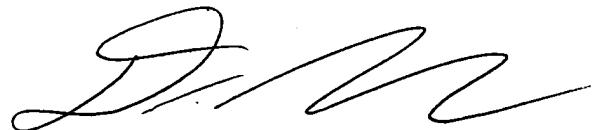
Art Unit: 3629

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262.

The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER